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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,968	10/01/2003	Katsuhisa Ogawa	1232-5170	9275
27123	7590	01/28/2008		
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER CLOUD, JOIYA M	
			ART UNIT 2144	PAPER NUMBER
			NOTIFICATION DATE 01/28/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/677,968

Applicant(s)

OGAWA, KATSUHISA

Examiner

Joiya M. Cloud

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-20 represent Method and apparatus for judging coincidence of addresses, and service provision method and service provision apparatus. Applicant's arguments and amendments filed 11/19/2007 have been carefully considered but are moot in view of the following new grounds of rejection as explained here below, necessitated by Applicant's substantial amendment (i.e., "*before the apparatus is connected to a second network; a second acquisition step of acquiring owner information of the apparatus...in accordance with the owner information acquired at the second acquisition step*") to the claims which significantly affected the scope thereof.

2.

Priority

Receipt is acknowledged of a certified copy of the 10/677,968 application referred to in the oath or declaration or in an application data sheet. If this copy is being filed to obtain the benefits of the foreign filing date under 35 U.S.C. 119(a)-(d), applicant should also file a claim for such priority as required by 35 U.S.C. 119(b). If the application being examined is an original application filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000, the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. See 37 CFR 1.55(a)(1)(i). If the application being examined has entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the

PCT and Regulations of the PCT. See 37 CFR 1.55(a)(1)(ii). Any claim for priority under 35 U.S.C. 119(a)-(d) or (f) or 365(a) or (b) not presented within the time period set forth in 37 CFR 1.55(a)(1) is considered to have been waived. If a claim for foreign priority is presented after the time period set forth in 37 CFR 1.55(a)(1), the claim may be accepted if the claim properly identifies the prior foreign application and is accompanied by a grantable petition to accept an unintentionally delayed claim for priority. See 37 CFR 1.55(c).

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Specification

Claims 1-15 are objected to because there is lack of antecedent basis in the specification for "storage medium". Therefore, 35 U.S.C. 101 rejections are maintained. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 11-15** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims may be directed towards software only, which is functional descriptive material, which per se is not statutory.

As per claims 11-15, claims 11-15 are directed towards a program for judging coincidence of address that may be directed towards software only, which is functional descriptive material, which may be software per se, which is nonstatutory.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-20**, are rejected under 35 U.S.C. 102(b) as being anticipated by Saito et al. (U.S. Patent No. 6,065,064, hereinafter Saito).

As per claim 1, Saito teaches a method of judging coincidence of addresses comprising: a first acquisition step of acquiring a host address of an apparatus connected to a first network before the apparatus is connected to a second network (**Abstract, paragraphs [0124], [0138], and [0143], wherein Saito teaches determining a coincidence of address through a judgement step**); a second acquisition step of acquiring owner information of the apparatus; a third acquisition step of acquiring a network address of a second network (**paragraphs [0124], [0138], and [0143]**); a fourth acquisition step of acquiring a host address and a network address of a sending side of a signal from the apparatus connected to the second network (**paragraphs [0124], [0138], and [0143]**)and; and a judgment step of judging whether or not the host address acquired in said first acquisition step and the network address acquired in said second acquisition step coincide with the host address and the network address acquired in said third acquisition step (**paragraphs [0124], [0138], and [0143]**).

As per claim 2, Saito teaches a method wherein, in said first acquisition step, the host address of the apparatus connected to the first network in an apparatus factory is acquired (paragraph [0106], [0094]).

As per claim 3, Saito teaches a method wherein said judgment step has a provision step of providing a service to the apparatus connected to the second network in the case in which a judgment result shows coincidence of the host addresses and the network addresses (paragraphs [0124], [0138] and [0143] [0003], and [0005]).

As per claims 4 and 5, Saito teaches a method wherein, in said third acquisition step, a part of the network address of the second network is acquired from an Internet service provider for connecting the second network to the Internet and wherein, in said third acquisition step, a part of the network address of the second network is acquired from a DNS server (paragraphs [000]-[0006]).

As per claims 6-10, claims 6-10 lists all the same limitations as claims 1-5 but in apparatus rather than method form. Therefore, the rejection of claims 1-5 applies equally as well in claims 6-10.

As per claims 11-15, claims 11-15 lists all the same limitations as claims 1-5 but in program form rather than method form. Therefore, the rejection of claims 1-5 applies equally as well in claims 11-15.

As per claims 16-20, claims 16-20 lists substantially the same limitations as claims 1-5 and thus are rejected using similar rationale.

CONCLUSION

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joiya Cloud whose telephone number is 571-270-1146. The examiner can normally be reached Monday to Friday from on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3922. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from

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either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMC

William C. Vaughn

Supervisory Patent Examiner

January 21, 2008


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